



UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

9596-6101-12 02/22/00 SWEENEY

H 9596-6101-(2

000570
AKIN, GUMP, STRAUSS, HAUER & FELD, L.L.P.
ONE COMMERCE SQUARE
2005 MARKET STREET, SUITE 2200
PHILADELPHIA PA 19103

HM12/0828

EXAMINER

BAKER, A

ART UNIT

PAPER NUMBER

1632

DATE MAILED:

08/28/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/510,268

Applicant(s)

SWEENEY ET AL.

Examiner

Anne-Marie Baker

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 19-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 February 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) ☐ Other:

Application/Control Number: 09/510,268

Page 2

Art Unit: 1632

DETAILED ACTION

The response filed June 8, 2001 (Paper No. 7) has been entered. Applicants' election of Group I, Claims 1-18 and 23, without traverse, is acknowledged. The elected invention is drawn to a method of increasing muscle mass in a vertebrate by administering a nucleic acid encoding insulin-like growth factor I, an isolated nucleic acid, a recombinant virus vector, a host cell, and a kit for increasing muscle mass.

Claims 19-22 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected invention. Election was made **without** traverse in Paper No. 7.

Claims 1-18 and 23 are examined herein.

Priority

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) and 120 as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification (37 CFR 1.78).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-18 and 23 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art

Art Unit: 1632

that the inventors, at the time the application was filed, had possession of the claimed invention. Applicants are referred to the guidelines on written description published January 5, 2001 in the Federal Register at Volume 66, Number 4, pp. 1099-1111 (also available at www.uspto.gov).

The claims are directed to a method of increasing vertebrate muscle mass and muscle strength by administering a muscle enhancing dose of an isolated nucleic acid encoding insulin-like growth factor I (IGF-I), or a modification or biologically active portion thereof. The claims are further directed to a nucleic acid comprising a vertebrate IGF-I coding region, or a modification or portion thereof, a composition comprising said nucleic acid construct, a cell comprising said nucleic acid construct, and a kit comprising said nucleic acid construct.

However, the specification does not provide a written description of a modified IGF-I coding region or a portion of the IGF-I coding region that will produce the claimed effect of increasing muscle mass and muscle strength. In analyzing whether the written description requirement is met for genus claims, it is first determined whether a representative number of species have been described by their complete structure. In the instant case, only the full-length, unmodified IGF-I coding sequence was used to produce the claimed effect. Next then, it is determined whether a representative number of species have been sufficiently described by other relevant identifying characteristics. In this case, the specification does not describe any modified or portion of an IGF-I coding sequence by other relevant identifying characteristics. This limited information is not deemed sufficient to reasonably convey to one skilled in the art that Applicants were in possession of a modification or biologically active portion of an IGF-I coding sequence, at the time the application was filed. Thus, it is concluded that the written description requirement is not satisfied for the claimed genus of modified IGF-I coding sequences and portions of IGF-I coding sequences.

Art Unit: 1632

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6, 8-10, 13, 14, 15, 17, and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite in its recitation of "the muscle" because the term lacks antecedent basis. Furthermore, it is unclear if only a single muscle is affected. Claims 2-6 and 23 are indefinite in so far as they depend from Claim 1.

Claim 8 is indefinite in its recitation of "selected from a group consisting of" because this phrasing is improper Markush terminology. The phrase should recite "selected from the group consisting of." Claims 9 and 10 are indefinite in so far as they depend from Claim 8.

Claim 9 is indefinite in its recitation of "[t]he method of Claim 8" because Claim 8 is directed to an isolated nucleic acid, not a method. Thus, the phrase lacks antecedent basis.

Claim 13 is indefinite in its recitation of "said isolated nucleic acid of claim 12" because the phrase lacks antecedent basis. Claims 14, 15, and 17 are indefinite in so far as they depend from Claim 13.

Conclusion

No claim is allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne-Marie Baker whose telephone number is (703) 306-9155. The examiner can normally be reached Monday through Thursday and alternate Fridays from 9:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Karen Hauda, can be reached on (703) 305-6608. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-8724.

Application/Control Number: 09/510,268

Page 5

Art Unit: 1632

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the patent analyst, Kay Pinkney, whose telephone number is (703) 305-3553.

Anne-Marie Baker, Ph.D.

Anne-Marie Baker

ANNE-MARIE BAKER
PATENT EXAMINER